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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/018,483 | 12/19/2001 | Izaak Den Daas | MERCK 2340 | 8101 |
| 23599 | 7590 | 06/28/2005 | EXAMINER | |
| MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201 | | | GUCKER, STEPHEN | |
| | | ART UNIT | | PAPER NUMBER |
| | | | | 1649 |

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 10/018,483 | DAAS ET AL. |
| Examiner | Art Unit | |
| | Jon M. Lockard | 1647 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 19 December 2001.
2a) This action is **FINAL**. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) _____ is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) 1-11 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: *GenBank Accession No. AAD34061.*

DETAILED ACTION***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3 and 9, drawn to polypeptides.

Group II, claim(s) 4-8, drawn to polynucleotides, vectors and host cells comprising said polynucleotides, and a method of recombinantly producing the polypeptide encoded thereby.

Group III, claim(s) 10, drawn to antibodies.

Group IV, claim(s) 11 (in part), in so far as they are drawn to methods of screening candidate compounds that stimulate or inhibit the activity of a polypeptide.

Group V, claim(s) 11 (in part), in so far as they are drawn to methods of screening candidate compounds that stimulate or inhibit the expression of a mRNA encoding a polypeptide.

2. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I is directed to an isolated polypeptide having at least 95% sequence identity to the polypeptide sequence of SEQ ID NO:2. However, since Lai et al. (Genome Research 10(5):703-713, 2000; Accession No: AAD34061, published 18 May 2000) teaches a polypeptide that is identical to SEQ ID NO:2 of the instant application, no special technical feature exists for Group I as defined by PCT Rule 13.2, because it does not define a contribution over the prior art. Because the technical feature of Group I is not a special technical feature, and because the technical features of the Groups II-V inventions is not present in the Group I claims, unity of invention is lacking.

Rejoinder Under Ochiai/Brouwer

3. The Examiner has required restriction between product and method claims. Where applicant

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elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn method claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Method claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

4. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined method claims will be withdrawn, and the rejoined method claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and method claims may be maintained. Withdrawn method claims that are not commensurate in scope with an allowed product claim will not be rejoined. See “Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b),” 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the method claims should be amended during prosecution either to maintain dependency on the method claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

5. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the Examiner before the patent

issues. See MPEP § 804.01.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jon M. Lockard, Ph.D.** whose telephone number is **(571) 272-2717**. The examiner can normally be reached on Monday through Friday, 8:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Brenda Brumback**, can be reached on **(571) 272-0961**.

The fax number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

JML
June 24, 2005

Brenda Brumback
BRENDA BRUMBACK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

NCBI Protein

PubMed Nucleotide Protein Genome Structure PMC Taxonomy OMIM Books

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Limits Preview/Index History Clipboard Details

Display GenPept all to file

Range: from begin to end Features: SNP CDD MGC HPRD STS

1: AAD34061. Reports CGI-66 protein [H...[gi:4929601] BLink, Domains, Links

LOCUS AAD34061 341 aa **linear** **PRI** 18-MAY-2000

DEFINITION CGI-66 protein [Homo sapiens].

ACCESSION AAD34061

VERSION AAD34061.1 GI:4929601

DBSOURCE locus AF151824 accession AF151824.1

KEYWORDS .

SOURCE Homo sapiens (human)

ORGANISM Homo sapiens
Eukaryota; Metazoa; Chordata; Craniata; Vertebrata; Euteleostomi; Mammalia; Eutheria; Euarchontoglires; Primates; Catarrhini; Hominidae; Homo.

REFERENCE 1 (residues 1 to 341)

AUTHORS Lai,C.H., Chou,C.Y., Ch'ang,L.Y., Liu,C.S. and Lin,W.

TITLE Identification of novel human genes evolutionarily conserved in *Caenorhabditis elegans* by comparative proteomics

JOURNAL Genome Res. 10 (5), 703-713 (2000)

PUBMED 10810093

REFERENCE 2 (residues 1 to 341)

AUTHORS Lin,W.-C.

TITLE Direct Submission

JOURNAL Submitted (17-MAY-1999) Institute of Biomedical Sciences, Academia Sinica, No. 128, Sec. II, Academia Road, Taipei 115, Taiwan

COMMENT Method: conceptual translation supplied by author.

FEATURES Location/Qualifiers

source 1..341
/organism="Homo sapiens"
/db_xref="taxon:9606"

Protein 1..341
/product="CGI-66 protein"

CDS 1..341
/coded_by="AF151824.1:1..1026"

ORIGIN

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